

REMARKS

The Office Action mailed January 10, 2002, has been carefully considered. The present amendment is intended to be a complete response thereto and to place the case in condition for allowance. A Request for Continued Examination (RCE) is filed concurrently herewith. The present amendment is intended as a submission required under 37 C.F.R. § 1.114 and is submitted concurrently with the RCE.

REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claim 14 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey that the inventor had possession of the claimed invention at the time the application was filed. The Examiner states that the specification does not provide a basis for “co-polymers of “polyvinyl chloride” or “chlorinated polyvinyl chloride”. Claim 14 has been amended to include only substances recited on page 5, lines 12-17.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 14 and 15 stand rejected under 35 U.S.C. § 112, second paragraph, for being indefinite.

Claim 14 is rejected because “chlorinated polyvinyl chloride” does not make sense as it is already chlorinated. Claim 14 has been amended to remove “chlorinate polyvinyl chloride”.

Claim 15 are rejected because “butyl glycol”, “diethyl glycol”, and “dimethyl glycol” are not chemical names. Claim 15 has been amended to replace “butyl glycol”, “diethyl glycol”, and “dimethyl glycol” with butylene glycol, diethylene glycol, and dimethylene glycol, respectively.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 11, 12, 14 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamura et al. (U.S. Patent No. 5,492,792). Claims 11-14 and 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamura et al. in view of Sasakawa et al. (U.S. Patent No. 5,283,094). Claims 11-14 and 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamura et al. in view of Sasakawa et al., and further in view of Sato et al. (U.S. Patent No. 4,752,554).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP 2143.

The references, taken alone or in combination, do not teach every element of the invention. Tamura et al. does not teach a fluorescent dye as required by claims 11 and 18 of the present invention. The dye of Tamura et al. is a polymethine dye that does not fluoresce. Fluorescent dye differs from polymethine dye in that the fluorescent dye emits electromagnetic radiation, especially visible light, due to stimulation by an incident radiation. On the other hand, polymethine dye, like other non-fluorescent dye, merely absorbs and/or reflects light. The fluorescent dye actually modifies the light incident upon it, while polymethine dye merely absorbs and/or reflects the incident light.

The disclosure of Tamura et al. actually disclose that polymethine dye is a non-fluorescent dye by the measuring of transmittance of the recording layer to light at 830 nm (see

column 29, lines 1-5). Measuring transmittance would have no meaning for Applicant's invention because the light would have been absorbed, transformed, and emitted a different wavelength. Therefore, Tamura et al. fails to disclose a fluorescent dye. And this deficiency is not satisfied by Sasakawa et al. and Sato et al.

Further, the Examiner provides no motivation or suggestion to use a fluorescent dye in the recording media of Tamura et al., Sasakawa et al. and Sato et al. The references offer no motivation or suggestion to use a fluorescent dye. Actually, Tamura et al. teaches away the present invention by disclosing only a non-fluorescent dye (polymethine dye).

Therefore, because the references fail to teach a fluorescent dye and fail to provide a motivation or suggestion to use a fluorescent dye, the claims are not obvious within the meaning of § 103. Accordingly, the rejections are improper and should be withdrawn.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

Applicant has responded to the Office action mailed January 10, 2002. All pending claims are now believed to be allowable and favorable action is respectfully requested.

In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

Please charge any shortage or credit any overpayment of fees to BLANK ROME COMISKY & McCAULEY LLP, Deposit Account No. 23-2185 (109289-00121). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, applicant hereby petitions under 37 C.F.R.

1.136(a) for an extension of time for as many months as are required to render this submission timely.

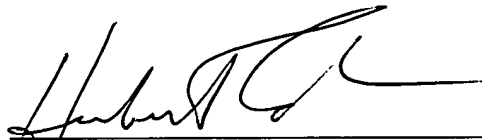
Any fees due are authorized above.

Respectfully submitted,

ALPEROVICH et al.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please amend the claims as follows:

14. (Amended) The disc of claim 11, wherein the film-forming polymer comprises a substance selected from the group consisting of ~~polyvinyl chloride and its co-polymers, chlorinated polyvinyl chloride and nitrocellulose~~ cellulose esters, cellulose ethers, vinyl resins, and acrylic resins.

15. (Amended) The disc of claim 11, wherein the surfactant comprises a substance selected from the group consisting of butylene glycol, propylene glycol, dimethylene glycol and diethylene glycol.